

REMARKS

The Final Office Action mailed July 6, 2005 has been carefully reviewed and the foregoing amendments have been made as a consequence thereof.

Claims 1-15 are pending in this application. Claims 1-10 have been amended herein. Claims 1-15 stand rejected.

The rejection of Claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,731,201 (Bailey) in view of U.S. Patent No. 6,609,204 (Olarig) is respectfully traversed.

Claim 1 recites a communication and power line diagnostics system comprising, among other things, “a diagnostics module configured to diagnose the power line....”

Neither Bailey nor Olarig, considered alone or in combination, describe or suggest a communication and power line diagnostics system including a diagnostics module configured to diagnose a power line, as recited in Claim 1. Because Bailey and Olarig fail to individually teach and/or suggest one or more elements of Claim 1, it follows that a combination of Bailey and Olarig also fails to teach and/or suggest such element(s). Accordingly, Claim 1 is respectfully submitted to be patentable over Bailey in view of Olarig.

Claims 2-9 depend from independent Claim 1. When the recitations of Claims 2-9 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-9 likewise are patentable over Bailey in view of Olarig.

Claim 10 recites a method of communicating data between an appliance and a power line carrier using a communication interface, wherein the method comprises, among other things, “diagnosing the power line carrier....”

Neither Bailey nor Olarig, considered alone or in combination, describe or suggest a method of communicating data between an appliance and a power line carrier using a communication interface, wherein the method includes diagnosing the power line carrier, as

recited in Claim 10. Because Bailey and Olarig fail to individually teach and/or suggest one or more elements of Claim 10, it follows that a combination of Bailey and Olarig also fails to teach and/or suggest such element(s). Accordingly, Claim 10 is respectfully submitted to be patentable over Bailey in view of Olarig.

Claims 11-15 depend from independent Claim 10. When the recitations of Claims 11-15 are considered in combination with the recitations of Claim 10, Applicants respectfully submit that dependent Claims 11-15 likewise are patentable over Bailey in view of Olarig.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-15 be withdrawn.

Moreover, Applicants respectfully submit that the Section 103 rejection of presently pending Claims 1-15 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to combine Bailey with Olarig. More specifically, it is respectfully submitted that a *prima facie* case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

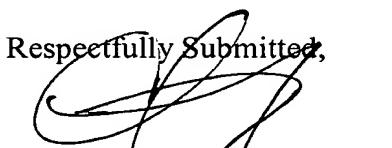
[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching or suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-15 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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